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GO DADDY GROUP, INC.
14455 NORTH HAYDEN ROAD
SUITE 219
SCOTTSDALE, AZ 85260

EXAMINER	
SALL, EL HADJI MALICK	

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inventions@godaddy.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHIP MAXSON and SHAWN FITZPATRICK

Appeal 2009-006314
Application 10/616,005[1]
Technology Center 2400

Before JOHN A. JEFFERY, JAY P. LUCAS, and JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL[2]

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[1] Application filed July 8, 2003. The real party in interest is The Go Daddy Group, Inc. (App. Br. 1.)

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellants appeal from the Examiner's rejection of claims 1-20 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' Invention

Appellants invented a reseller program (system) and related process for registration by customers of domain names with a registrar, and more specifically, for reseller web sites to register domain names for customers through a registrar's web site. (Spec. 1, ll. 17-20; 5, l. 9 to 6, l. 5.)[3]

Representative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

> 1. A reseller program utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a registrar web site, comprising:
>
> A) means for accepting a plurality of Resellers into a reseller program, wherein each Reseller has at least one reseller web site;
>
> B) means for creating a registrar web site for registering domain names with an appropriate Registry web site;
>
> C) means for allowing a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site; and

[3] We refer to Appellants' Specification ("Spec."); Appeal Brief ("App. Br.") filed January 11, 2008; and Reply Brief ("Reply Br.") filed May 15, 2008. We also refer to the Examiner's Answer ("Ans.") mailed April 8, 2008.

D) means for collecting a fee from each Reseller web site that registers a domain name for a Customer via the registrar web site.

References

The Examiner relies on the following reference as evidence of unpatentability:

Vaidyanathan	US 2002/0138291 A1	Sept. 26, 2002
Bayles	US 7,039,697 B2	May 2, 2006 (filed Nov. 1, 2001)

Rejections on Appeal

The Examiner rejects claims 1-9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.[4]

The Examiner rejects claims 1-17 and 20 under 35 U.S.C. § 102(e) as being anticipated by Bayles.

The Examiner rejects claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bayles and Vaidyanathan.

ISSUES

Based on our review of the administrative record, Appellants' contentions, and the Examiner's findings and conclusions, the pivotal issues before us are as follows:

[4] The Examiner's statement of rejection actually states that claims 1-7 are rejected under § 101. However, the stated rejection excludes Appellants' dependent claims 8 and 9 that depend on rejected independent claim 6, and which include language similar to rejected claim 7 and engenders the same issues. Therefore, we view the Examiner's omission of claims 8 and 9 as harmless typographical error, which we have corrected to provide greater clarity.

1. Does the Examiner err in rejecting Appellants' claims 1-9 under 35 U.S.C. § 101? The issue turns on whether the claimed subject matter is statutory subject matter.

2. Does the Examiner err in finding the Bayles reference discloses means for allowing reseller web sites to register domain names for customers via a registrar web site?

3. Does the Examiner err in finding the Bayles reference discloses a Reseller customizing the registrar web site for the Reseller's Customers using an administration web site?

FINDINGS OF FACT (FF)

Bayles Reference

1. Bayles describes a system and method for monitoring and acquiring domain names. (Abst.; col. 1, ll. 24-26; col. 4, l. 61 to col. 5, l. 28.) Bayles provides a domain name monitor and acquire service through an intermediate entity integrated with the registry (registry provider), where current domain name registrars and retailers offer the monitor and acquire service of the intermediate entity through their web sites. (Col. 4, l. 61 to col. 5, l. 46.) Bayles explains that:

> According to the present invention, any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site. Customers can sign up to have the status of a desired name monitored and the name acquired or re-acquired automatically. The retailer no longer needs to perform the monitoring and acquiring steps itself. Rather, the retailer is acting like a reseller of these services. The services are actually provided by a single (i.e.,

> only one is permitted per registry) intermediary entity or software routine implemented at the registry. The intermediary, or the registry implementing software consistent with the present invention, maintains databases of all domain names for which any "retailer" requests monitoring or acquisition on behalf of its customers; together with information identifying the customer.

(Col. 5, ll. 29-46.) Specifically, Bayles provides a domain name monitor and acquire service through the intermediate entity integrated at the registry level, which receives input from one or more registrars. (Col. 7, ll. 1-12.) The system is "accessible to many registrars." (Col. 7, l. 32.) The Registrars may interact with the registry in two ways, either in the current manner, or through the intermediate entity. (Col. 7, ll. 37-43; *see* col. 7, l. 13 to col. 8, l. 21; Fig. 1.) In the second embodiment utilizing the intermediate entity or "Integrated Domain Acquisition Service ('IDAS')" (col. 7, ll. 37-51), the registrar communicates with an IDAS "front end computer 116" coupled to an IDAS "acquisition engine and database management system 118" that communicates with an IDAS "database 120." (Col. 7, ll. 13-27; *see* col. 7, l. 52 to col. 8, l. 21; Fig. 1.)

ANALYSIS

Issue 1: Rejection of Claims 1-9 under § 101

The Examiner finds that Appellants' reseller program utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a registrar web site must be embedded in a computer readable medium in order to be statutory, but that it is not. (Ans. 4.) The Examiner further finds that even if a "reseller program" is a "group of individuals with a common purpose" (of reselling), such a group does not

fall within a statutory category, and is therefore non-statutory subject matter. (Ans. 9.) Appellants contend that the Examiner misinterprets the claim language – in that their recited program is not a computer program per se, but instead a "group of individuals" (App. Br. 6-7), and that the claim as a whole is directed to a machine – which is statutory subject matter (Reply Br. 7-8). Accordingly, we decide the question of whether the Examiner erred in rejecting Appellants' claims 1-9 under § 101 as being directed to non-statutory subject matter.

We find that Appellants' independent claims 1 and 6 recite a reseller program – a group of resellers – utilizing a computer network to register domain names (either through a Registrar, or a registrar web site), and utilizing various web sites (registrar web site and reseller web site). Consequently, Appellants' claims implicate the use of machines including the explicitly stated computer network, and various specially programmed computers for implementing websites – software operating on computer servers accessible by a network of computers (the Internet). *See In re Comiskey*, 554 F.3d 967, 981 (Fed. Cir. 2009) (explaining that reciting networks and the Internet implicate the use of a machine). We "need not resolve the particular class of statutory subject matter into which" Appellants' reseller program claims fall, but "the claims must satisfy at least one category." *In re Ferguson*, 558 F.3d 1359, 1365 (Fed. Cir. 2009). Here, Appellants recite claim limitations implicating use of a machine – "a concrete thing, consisting of parts, or of certain devices and combination of devices." *In re Nuijten*, 500 F.3d 1346, 1355 (Fed. Cir. 2007). Thus, we conclude that Appellants' independent claims 1 and 6 (and dependent claims 2-5 and 7-9) are directed to statutory subject matter, and that the Examiner

has erred in rejecting Appellants' claims 1-9 under § 101. Accordingly, we reverse the Examiner's § 101 rejection of Appellants' claims 1-9.

Issue 2: Rejection of Claims 1-5 and 10-13 under § 102

Appellants contend that Bayles does not disclose at least one limitation of independent claims 1 and 10. (App. Br. 7-10; Reply Br. 8-12.) Specifically, "means for allowing a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site" as recited in claim 1, and a limitation of commensurate scope in claim 10. (App. Br. 8.) The Examiner finds that the Bayles reference discloses the disputed feature of Appellants' claims 1 and 10. (Ans. 5, 6, 9-10.) Accordingly, we decide the question of whether the Examiner erred in finding the Bayles reference discloses means for allowing reseller web sites to register domain names for customers via a registrar web site.

After reviewing the record on appeal, we agree with Appellants and find that Bayles does not disclose the disputed features. We initially note that both claims 1 and 10 recite a "Registry web site," a "registrar web site" or "Registrar web site," and a "reseller web site" or "Reseller web site." (App. Br. 18, 19; Claim App'x, claims 1 and 10.) Consequently, we understand the claims as requiring separate reseller, registrar, and registry web sites.

As detailed in the Findings of Fact section *supra*, Bayles describes an intermediate entity and/or service integrated with the registry and/or registry provider – an Integrated Domain Acquisition Service ("IDAS") that allows current domain name registrars and retailers to offer the domain name service through their web sites. In particular, Bayles describes the system (intermediate entity or IDAS) as accessible to and receiving input from

multiple registrars. The Registrars may interact with the registry in two ways, either in the current manner – each registrar performing their own domain name searches and registering available domain names – or through the IDAS. In the preferred embodiment, a retailer (current registrar, retailer, and/or reseller) requests domain name services through the intermediate entity (IDAS system), and the registrar (retailer/reseller) communicates directly with the IDAS front end computer coupled to an IDAS acquisition engine and database management system that communicates with an IDAS database. (FF 1.)

We agree with the Examiner that Bayles discloses a system that allows reseller web sites – current registrar and/or reseller and/or retailer web sites – to register domain names for their customers. We find, however, that the Bayles reference also describes a registrar (registrar's web site) communicating directly with the registry. The registrar either performs the domain name services itself (registers domain names in the registry), or sends requests for domain name services directly to the intermediate entity or IDAS system integrated in the registry system that performs the services (registers domain names in the registry). Thus, we find that Bayles describes only a single entity (registrar/registrar's web site) between the customer and the registry. Bayles' customers purchase domain name services from the registrar/reseller that sends requests for the domain name services directly to IDAS system integrated in the registry system. The IDAS system performs the requested services and notifies the registrar.

As we discussed *supra*, Appellants' claims recite a reseller (reseller web site) registering domain names for its customers through a registrar (registrar web site) that registers the domain names with a registry website.

There is simply no explicit or inherent disclosure in Bayles of four separate entities – a customer, a reseller, a registrar, and a registry – interacting to register a domain name as required by Appellants' claims, much less that the reseller, registrar, and registry each have separate web sites. Bayles can be interpreted to disclose a reseller web site or a registrar web site communicating with the registry to register domain names, but not both distinct web sites. Thus, we are constrained by the record before us to find that Bayles does not disclose a reseller web site registering domain names using a registrar website. Consequently, we find that Bayles does not disclose the disputed limitation – "means for allowing a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site," and does not anticipate Appellants' claim 1.

Appellants' independent claim 10 includes a limitation similar in scope to the disputed limitation of claim 1. It follows, for the reasons discussed with respect to claim 1 *supra*, that Bayles does not disclose each limitation of Appellants' claim 10. Appellants' dependent claims 2-5 and 11-13 depend on the respective base independent claims (claims 1 and 10).

Therefore, based on the record before us, we find that the Examiner erred in finding that the Bayles reference discloses each of the disputed features of Appellants' claims 1-5 and 10-13. Accordingly, we reverse the Examiner's anticipation rejection of claims 1-5 and 10-13.

Issue 3: Rejection of Claims 6-9, 14-17, and 20 under § 102

Appellants contend that the Examiner fails to point out where in Bayles the specific limitations of Appellants' claims 6 and 14 are taught, and that the Examiner "never addresses the unique elements in claims 6 and 14." (App. Br. 11.) Appellants further contend that Bayles fails to disclose "the

claim limitation in claim 6 of 'allowing each Reseller to customize the registrar web site for the Reseller's Customers' and the claim limitation in claim 14 of 'the Reseller customizing an appearance of a registrar web site for the Reseller's Customers from the administration web site.'" (Reply Br. 13; *see* Reply Br. 12-13.) The Examiner purportedly finds that the Bayles reference discloses the features of claims 6 and 10, stating that "[a]s to claims 1, 6, 10 and 14, Bayles teaches a reseller program embodied in a machine readable medium and a process for allowing a plurality of Customers to register one or more domain names via a Registrar web site...." (Ans. 5; Fin. Rej. 4.) The Examiner also provides an additional response explaining how Bayles discloses the disputed features – "Bayles discloses [that] . . . . [c]ustomers can sign up to have the status of a desired name monitored and the name acquired or re-acquired automatically (i.e. 'allowing each Reseller to customize the registrar web site for the Reseller's Customers')." (Ans. 10.) Based on these contentions, we decide the question of whether the Examiner erred in finding the Bayles reference discloses a Reseller customizing the registrar web site for the Reseller's Customers using an administration web site.

After reviewing the record on appeal, we agree with Appellants that Bayles does not disclose "allowing each Reseller to customize the registrar web site for the Reseller's Customers" as recited in Appellants' claim 6, nor "the Reseller customizing an appearance of a registrar web site for the Reseller's Customers from the administration web site" as recited in Appellants' claim 14. Specifically we find that the Examiner has failed to establish that Bayles discloses an administration web site, much less utilizing such a web site to customize a registrar web site. Simply pointing

out that Bayles allows a customer to request domain name services (Ans. 10) falls far short of such a disclosure. In our review of the Bayles reference, we find no description of any web site in addition to the registrar web site discussed *supra*.

Thus, we are constrained by the record before us to find that Bayles neither discloses an administration web site, nor a reseller utilizing a separate web site to customize a registrar web. Consequently, we find that Bayles does not disclose the disputed limitations and does not anticipate Appellants' independent claim 6 or independent claim 14. Appellants' dependent claims 7-9, 15-17, and 20 depend on the respective base independent claims (claims 6 and 14).

Therefore, based on the record before us, we find that the Examiner erred in finding that the Bayles reference discloses each of the disputed features of Appellants' claims 6-9, 14-17, and 20. Accordingly, we reverse the Examiner's anticipation rejection of claims 6-9, 14-17, and 20.

Rejection of Claims 18 and 19 under § 103

Appellants' claims 18 and 19 depend on claim 14 discussed *supra*. Claims 18 and 19 both recite the administration web site offering additional features. As set forth *supra*, we find that Bayles falls short of disclosing, teaching, or suggesting an administration web site, much less the administration web site offering additional features or functionality. The Vaidyanathan reference does not cure this deficiency. Consequently, we are constrained by the record before us to find that the combination of Bayles and Vaidyanathan does not collectively teach or suggest the disputed limitations of Appellants' claims 18 and 19. It follows that Appellants have shown that the Examiner erred in finding that the combination of Bayles and

Vaidyanathan renders Appellants' claims 18 and 19 obvious. Accordingly, we reverse the Examiner's obviousness rejection of claims 18 and 19.

CONCLUSIONS OF LAW

Appellants have shown that the Examiner erred in rejecting claims 1-9 under 35 U.S.C. § 101.

Appellants have shown that the Examiner erred in rejecting claims 1-17 and 20 under 35 U.S.C. § 102(e).

Appellants have shown that the Examiner erred in rejecting claims 18 and 19 under 35 U.S.C. § 103(a).

DECISION

We reverse the Examiner's rejection of claims 1-9 under 35 U.S.C. § 101.

We reverse the Examiner's rejection of claims 1-17 and 20 under 35 U.S.C. § 102(e).

We reverse the Examiner's rejections of claims 18 and 19 under 35 U.S.C. § 103(a).

REVERSED

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Go Daddy Group, Inc.
14455 North Hayden Road
Suite 219
Scottsdale, AZ 85260